

REMARKS:

CLAIM AMENDMENTS

The Applicants have amended claims 1 and 23 to recite that the first and second sets of comb fingers interdigitate in a substantially co-planar fashion at some rotation. [emphasis added].
5 Support for this feature can be found in the specification in the section bridging page 10, line 26 to page 11, line 18. As such, no new matter has been added with this amendment.

CLAIM REJECTIONS

35 USC 102

The Examiner has rejected claims 1-2, 4-24 and 26-36 under 35 U.S.C. 102(b) as being
10 anticipated by U.S. Patent 5,959,760 to Yamada et al. (hereinafter Yamada). In rejecting the claims, the Examiner states that Yamada teaches every element of the rejected claims.

The Applicants respectfully traverse the rejections. To expedite prosecution, the Applicants have amended claims 1 and 23 to recite that the first and second sets of comb fingers interdigitate in a substantially co-planar fashion at some rotation. [emphasis added]. The Applicants submit that
15 Yamada is devoid of any teaching or suggestion of such a feature. Instead, Yamada clearly teaches that the first and second sets of comb fingers are vertically offset (see, e.g., Figs. 2B, 3A-3H, 7B, 8B, 10B, 11B and 12B). Yamada specifically teaches that the electrodes 7a, 7b in Fig. 2B are higher than the electrode section 5 of the mirror (see col. 5, lines 25-38). A similar configuration is shown in Fig. 12B of Yamada. Consequently, Yamada's fixed comb fingers 7a,
20 7b and electrode section 5 cannot interdigitate in a substantially co-planar fashion as recited in claims 1, and 23. Instead, they interdigitate at some angle, e.g., as shown in Fig. 3B or Fig. 3F. Thus, Yamada does not teach all the limitations of claims 1 and 23 as they presently stand in the application. Therefore, claims 1 and 23 are not anticipated by Yamada. As such, independent claims 1 and 23 define an invention suitable for patent protection.

25 In addition, dependent claims 2, 4-22 24 and 26-36 depend, either directly or indirectly, from claims 1 and 23 and recite additional features therefor. As such, for the same reasons set forth

above, the Applicant submits that these dependent claims are not anticipated by Yamada and define an invention suitable for patent protection.

35 USC 103

Yamada

5 Examiner has rejected claims 3 and 25 under 35 USC 103 as being obvious over Yamada. In rejecting claims 3 and 25, the Examiner admits that Yamada does not teach means for applying a constant biasing force between the base and outer frame. The Examiner argues, however, that the Applicants have not disclosed a perceived criticality of this added feature and that the invention appears to work just as well without it. The Examiner reasons from this that the
10 features of claims 3 and 25 appear to be an obvious design choice. The Examiner concludes that one of skill in the art would have wanted to apply a constant biasing force between the outer frame and base of Yamada in order to provide an alternative and equivalent means for rotating the outer frame with respect to the base.

The Applicants respectfully traverses the rejections. Claims 3 and 25 depend from claims 1 and
15 23 respectively and recite additional features therefor. In addition, the Examiner himself admits that Yamada does not teach the means for applying a constant biasing force recited in claims 3 or 25. For the reasons set forth above, Yamada neither teaches nor suggests that the first and second sets of comb fingers interdigitate in a substantially co-planar fashion at some rotation, as presently recited in claims 1 and 23. Therefore, for the same reasons set forth above with respect
20 to claims 1 and 23, the Applicants submit that claims 3 and 25 define an invention suitable for patent protection. Furthermore, the Applicants submit that applying a constant biasing force is more than a mere design choice, as described in the specification at page 10, line 29 to page 11, line 7. Specifically, where the first and second sets of comb fingers interdigitate in a substantially co-planar fashion they may tend to remain interdigitated in a substantially co-planar
25 fashion absent a biasing force to move them out of interdigitation. As such, for at least this additional reason, the Applicants submit that claims 3 and 25 are not obvious over Yamada and define an invention suitable for patent protection.

Solgaard in view of Yamada

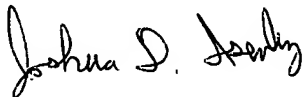
Claims 37-51 have been rejected as being obvious over US Patent 6,097,859 to Solgaard et al., (hereinafter, Solgaard) in further view of Yamada as applied to claims 1-36 above. In rejecting the claims, the Examiner states that Solgaard discloses a fiber-optic switch (10) comprising an array of input optical fibers (14); one or more arrays of mirrors (48); an array of output fibers (24); and microlenses. The Examiner admits that Solgaard does not expressly disclose the type of scanner recited in claims 37-51. The Examiner argues that Yamada discloses basically the same scanner as recited in these claims. The Examiner concludes that it would have been obvious to modify Solgaard in view of Yamada to obtain the invention of claims 37-51.

The Applicants respectfully traverse the rejection. Even if the Solgaard and Yamada references are combinable, the fact that they can be combined is not sufficient by itself to establish prima facie obviousness unless the prior art also suggests the desirability of the combination (*In re Mills*, 916 F.2d 680, 16 USPQ 1430 (Fed. Cir. 1990)). The Examiner has pointed to no teaching or suggestion within Solgaard or Yamada supporting the combination. Instead, the Examiner states that one would be motivated to combine these references *in order to obtain the invention* specified by claims 37-51. It is well established that the claims of the application in question cannot be used as a blueprint to find prior art. *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q.2d 543, 551 (Fed Cir. 1985) (improper to use claims as a frame and use individual parts of prior art as mosaic to recreate a facsimile of the invention.) The Examiner is arguing, in effect, that one of skill in the art would be motivated *by the claimed invention* and not by any teaching in the prior art. This is hindsight, the use of which is never permissible to establish obviousness. Therefore, the Examiner has not established a prima facie case of obviousness with respect to claims 37-51 since obviousness cannot be established absent some teaching, suggestion or incentive supporting the combination (*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants' teaching to hunt through the prior art for the claimed elements and combine them as claimed (see *In re Vaeck*, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); *In re Bond*, 910 F. 2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F. 2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989)).

CONCLUSION

For the reasons set forth above, the Applicant submits that all claims are allowable over the cited art and define an invention suitable for patent protection. The Applicants therefore respectfully request that the Examiner enter the amendment, reconsider the application, and issue a Notice of Allowance in the next Office Action.

Respectfully submitted,



10 Joshua D. Isenberg
Reg. No. 41,088
Patent Attorney

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15 JDI PATENT
204 Castro Lane
Fremont, CA 94539
tel.: (510) 896-8328
fax.: (510) 360-9656